THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAYMOND F. DALTON
and JOHN L. LENG

Appeal No. 1996-3990
Application No. 08/145,239

ON BRIEF

Before OWENS, WALTZ, and KRATZ, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 20 through 26, which are all of the claims pending in this application.

The appellants' invention relates to a composition including (A) one or more o-hydroxyaryloximes having at least 5 aliphatic or alicyclic carbon atoms and possessing specified extractant properties, and (B) one or more branched chain aliphatic or aliphatic-aromatic esters having 10 to 30 carbon

atoms with a specified ratio of methyl to non-methyl carbon atoms. The weight ratio of component A to B in the claimed composition is required to be within the range of 10:1 to 1:3. According to appellants (brief, pages 4 and 5), the claimed composition has improved hydrolytic stability and selectivity in extracting copper values from aqueous solutions of metal salts. An understanding of the invention can be derived from a reading of exemplary claim 20, which is reproduced below.

20. A composition for use in extracting copper values from aqueous solutions of metal salts which comprises

A) one or more o-hydroxyaryloximes containing at least 5 aliphatic or alicyclic carbon atoms which are strong metal extractants which, in 0.2 molar solution in an aliphatic hydrocarbon solution when loaded with 50% of the theoretical uptake of copper, will be in equilibrium with a 0.1 molar solution of copper as copper perchlorate at a pH less than 1: and

B) one or more branched chain aliphatic or aliphatic-aromatic esters containing 10 to 30 carbon atoms, wherein the ratio of the number of methyl carbon atoms to the number of non-methyl carbon atoms is higher than 1:5, the weight ratio of A to B being in the range 10:1 to 1:3.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Shanton	4,567,498	Jan. 28, 1986

Admitted prior art in specification[1] that hydroxyaryloximes are known copper extractants (Paper No. 7, page 2).

Claims 20-26 stand rejected under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Shanton.

OPINION

We have carefully reviewed the respective positions advanced by appellants and the examiner. In so doing, we find ourselves in agreement with appellants that the examiner has failed to establish that the applied references' teachings would have rendered the claimed subject matter obvious within the meaning of 35 U.S.C. § 103. Accordingly, we will not sustain the examiner's rejection.

The admitted prior art copper extractant relied upon by the examiner does not even contemplate component B of the composition and Shanton is directed to pressure sensitive record material, not compositions useful for copper

[1] The examiner does not specifically identify that portion of the subject specification which is being relied upon as admitted prior art; however, appellants do not dispute the examiner's assertion to the extent that "... hydoxyaryloximes are known copper extractants" (brief, page 7). We observe that an organic solvent solution of o-hydroxyaryloxime is acknowledged as a known metal extractant at page 1, lines 6-15 of appellants' specification.

extraction. In our view, a reasonably supportable basis for combining the teachings of the references has not come to light in the examiner's futile attempt to arrive at the claimed invention from the disparate teachings of the applied references. Moreover, even if the teachings of the admitted prior art and Shanton were combinable, the examiner has not established that the claimed composition would result as evident from the discussion that follows.

Another theory advanced by the examiner in support of the rejection is that Shanton alone may furnish sufficient evidence to render the claimed composition "... substantially met..." (answer, page 2) and hence obvious within the meaning of 35 U.S.C. § 103. However, the examiner has not furnished a convincing explanation as to why an ordinarily skilled artisan would have been led to pick a color developer corresponding to the claimed oxime and a solvent corresponding to the claimed ester for use in forming the record material of Shanton so as to somehow arrive at the claimed composition components from among the many choices for the developer and solvent disclosed by Shanton.

More fundamentally, there is no suggestion in Shanton of forming a composition including appellants' specified component oxime(s) and ester(s) in the particularly defined ratio as claimed. From our perspective, the assertions of the examiner regarding the reach of the teachings of Shanton appear to be based on conjecture and unsupported generalities, not facts as required. *See In re Freed*, 425 F.2d 785, 787, 165 USPQ 570, 571 (CCPA 1970). Here, the examiner's commentary to the effect that the claimed component ratio encompasses "... a very broad range" and that "remembering that the material of Shanton is subsequently dried, one would be inclined to use as little solvent as possible" essentially begs the question at hand and falls significantly short of establishing the *prima facie* obviousness of the claimed component range in the composition.

In summary, the only motivation and factual basis we can locate in support of the examiner's stated rejection is the description of appellants' invention in their specification. Hence, on this record, it is our view that the examiner used impermissible hindsight when rejecting the claims. Accordingly, we will not sustain the examiner's rejection.

CONCLUSION

The decision of the examiner to reject claims 20-26 under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Shanton is reversed.

REVERSED

TERRY J. OWENS Administrative Patent Judge	)
THOMAS A. WALTZ Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
PETER F. KRATZ Administrative Patent Judge	)

tdl

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APPEAL NO. - JUDGE KRATZ
APPLICATION NO. 08/145,239

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APJ OWENS

APJ WALTZ

DECISION: **REVERSED**

Prepared By: TINA

DRAFT TYPED: 27 Oct 00

FINAL TYPED: